

## REMARKS

By this amendment, no claims have been added, cancelled, or amended. Hence, Claims 1-20 are pending in the application.

The Office Action rejected Claims 1-20 under 35 U.S.C. §103(a) as being obvious over US Application No. 2004/0003398 to Donian (“*Donian*”). Specifically, the Office Action states that it would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of *Donian* implicitly shows the elements and limitations of the claims. However, Applicants respectfully submit that *Donian* does not expressly or inherently teach every element of the claimed invention. Therefore, the Office Action fails to present a *prima facie* case of obviousness, and the rejection of Claims 1-20 under §103(a) is respectfully traversed.

Claim 1 recites,

A method for determining which advertisements to include with electronic content delivered to users over a network, the method comprising the steps of:

storing sequence information that indicates a sequence for a plurality of advertisements, wherein each of said plurality of advertisements is associated with corresponding delivery criteria;

receiving a request to provide over said network a piece of electronic content that includes a slot for an advertisement;

comparing slot attributes of said slot with delivery criteria of said advertisements to determine a subset of said plurality of advertisements which qualify for inclusion in said slot; and

from said subset of advertisements, selecting an advertisement to include in the slot based, at least in part, on relative positions, within said sequence, of the advertisements in said subset.

The above combination of elements is not disclosed, taught, or suggested by *Donian*.

Applicants concede that at a high level, both the pending claims and *Donian* are directed towards placing advertisements in requested content. It is also acknowledged that the axiom of “know thy audience” was well recognized by advertisers, who were more likely to advertise beer during a football game than during a Saturday morning cartoon, and likewise were more likely to advertise a children’s toy during a Saturday morning cartoon than during a football game. However, beyond these sparse generalities, there is little in common between the pending claims and the approach of *Donian*.

*Donian* sheds little light on the process of selecting which advertisements to include in content. At best, *Donian* discloses that advertisements should be appropriate for the content in which they are included (See paragraphs 155 and 169). However, *Donian* completely lacks any discussion of the concept of arranging a plurality of advertisements in a sequence, let alone “storing sequence information that indicates a sequence for a plurality of advertisements” as required by Claim 1. Further, the portion of *Donian* cited to show this element (Paragraphs 10, 43, 52, 155, 143, 147, 148, 269, Abstract, FIG. 1, FIG. 6A, FIG. 7A, FIG. 7B, and FIG. 11C, and the whole document) does not even suggest “storing sequence information that indicates a sequence for a plurality of advertisements, wherein each of said plurality of advertisements is associated with corresponding delivery criteria.” Indeed, no portion of *Donian* even suggests that the approach of *Donian* takes into account a sequence that is associated with the advertisements.

As *Donian* lacks any suggestion of selecting an advertisement based on a relative position of the advertisement within a sequence of advertisements, it follows that *Donian* cannot possibly show “selecting an advertisement to include in the slot based, at least in part, on relative positions, within said sequence, of the advertisements in said subset” as required by Claim 1. The portion of *Donian* cited to show this element (Paragraphs 10, 43, 52, 155, 143, 147, 148, 269, Abstract, FIG. 1, FIG. 6A, FIG. 7A, FIG. 7B, and FIG. 11C, and the whole document) does not suggest how advertisements are selected for inclusion in content beyond the well-known axiom of “know thy audience,” e.g., paragraph 169 mentions that “the program selects appropriate ads to go with the media request list.” Thus, *Donian* fails to teach the above-quoted limitation of Claim 1.

As at least one element of Claim 1 is not disclosed, taught, or suggested by *Donian*, it is respectfully submitted that Claim 1 is patentable over the cited art, and is in condition for allowance. As each of Claims 2-20 contain limitations similar to those discussed above with respect to Claim 1, it is respectfully submitted that Claim 2-20 are also in condition for allowance for at least the same reasons are those presented above with respect to Claim 1.

## CONCLUSION

For the reasons set forth above, it is respectfully submitted that all of the pending claims are now in condition for allowance. Therefore, the issuance of a formal Notice of Allowance is believed next in order, and that action is most earnestly solicited.

The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any fee shortages or credit any overages Deposit Account No. 50-1302.

Respectfully submitted,

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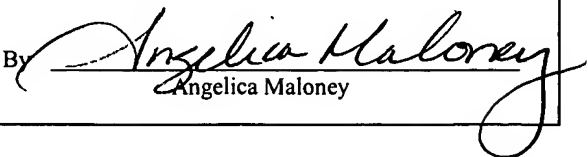
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### CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: **Mail Stop Amendment**, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

On October 8, 2004

By

  
Angelica Maloney